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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,220	04/09/2004	Semyon B. Mizakovsky	2100.006100	1318
7590 05/25/2010				
Terry D. Morgan Williams, Morgan & Amerson, P.C. Suite 1100 10333 Richmond Houston, TX 77042			EXAMINER PARTHASARATHY, PRAMILA	
			ART UNIT 2436	PAPER NUMBER
			MAIL DATE 05/25/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,220

Applicant(s)

MIZIKOVSKY, SEMYON B.

Examiner

PRAMILA PARTHASARATHY

Art Unit

2436

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 6-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Arguments

1. Applicant's arguments, see pages 7 – 10, filed on 2/10/2010, with respect to obviousness-type double patenting have been fully considered and are persuasive. The obviousness-type double patenting rejection of claims 1 – 11 has been withdrawn.
2. In view of the amendment to claim 11, Examiner withdraws 35 USC 101 rejection.
3. In view of the amendments to claims 1 – 10, Examiner withdraws prior art rejection.
4. Applicant's arguments with respect to 25 USC 112 second paragraph rejection is not persuasive. Examiner agrees that Fig.4 captures the instant invention, however the independent amended claims 1 and (now) 11 does not clearly recites the instant invention. Examiner directs the Applicant's attention to paragraphs [0030 – 0035]: deriving a [chap] key based on the SMEKEY and PLCM; using this CHAP-key (derived based on the SMEKEY and PLCM) to validate the CHAP response and re-authenticating the access terminal includes the steps of "using the chap key derived earlier during the original authentication process (i.e., using the CHAP-key (derived based on the SMEKEY and PLCM)).

Examiner maintains that that independent claim 1 and 11 does not capture the instant invention clearly and suggests amending the claims with dependent claim 6. Please see indicated allowable subject matter in item # 6.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 – 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent amended claims 1 and 11 recite "authenticating a user identity module", "deriving, at the access terminal, a key associated with the first authentication process" and "a secret key derived using information retrieved from a subscriber identity module". "a key associated with the first authentication process", "information retrieved from a subscriber module", however does not clearly define the limitations "using information", "associated with the first authentication process", "information" and/or distinctly claim the instant invention. Examiner directs the Applicant's attention to paragraphs [0030 – 0035]: deriving a [chap] key based on the SMEKEY and PLCM; using this CHAP-key (derived based on the SMEKEY and PLCM) to validate the CHAP response and re-authenticating the access terminal includes the steps of "using the chap key derived earlier during the original authentication process (i.e., using the CHAP-key (derived based on the SMEKEY and PLCM)). Examiner maintains that that independent claim 1 and 11 does not capture the instant invention clearly and suggests amending the claims with dependent claim 6.

Dependent claims are rejected by the virtue of their dependency on the above rejected parent claim(s).

Allowable Subject Matter

6. Claims 6 – 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRAMILA PARTHASARATHY whose telephone number is (571)272-3866. The examiner can normally be reached on 8:00a.m. to 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pramila Parthasarathy/
Primary Examiner, Art Unit 2436